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APR 26 2010

OFFICE OF PETITIONS

In re Application of	:	
Artavanis-Tsakonas et al.	:	DECISION ON APPLICATION
Application No. 10/781,059	:	FOR PATENT TERM ADJUSTMENT
Filed: February 17, 2004	:	
Attorney Docket No. 7326-132	:	

This is in response to the "Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(b)" filed October 9, 2009. Applicants request the initial determination of patent term adjustment be corrected from zero (0) days to at least one thousand three hundred seventy-six (1,376) days.

The request for reconsideration of the initial determination of patent term adjustment is **granted to the extent indicated herein**.

The Office has updated the PALM screen to reflect the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 157 days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application on July 10, 2009. Applicants were advised of a patent term adjustment to date of 0 days. In response, applicants timely filed this application for patent term adjustment with payment of the issue fee on October 9, 2009.

Delay Under 37 C.F.R. § 1.703(b)

To the extent applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. *See* 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

Applicant Delay Under 37 C.F.R. § 1.704 Involving Conduct Between
May 17, 2004, and August 25, 2006

Applicants dispute the propriety of the Office's entry of a 738-day reduction for alleged delay in responding to the Notice to File Missing Parts of Nonprovisional Application mailed May 17, 2004.

The period of 738 days is the number of days beginning May 17, 2004, the day after the date three months after the Office mailed the Notice to File Missing Parts, and ending on August 25, 2006, the date a reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice to Comply") was filed.

Background Facts

The Office mailed a Notice to File Missing Parts of Nonprovisional Application on May 17, 2004.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

A proper reply to the Notice to File Missing Parts was filed November 17, 2004.

A Notice to Comply was mailed April 12, 2006.

A reply to the April 12, 2006 Notice to Comply was filed June 12, 2006.

A second Notice to Comply was mailed June 29, 2006.

A reply to the June 29, 2006 Notice to Comply was filed August 25, 2006.

Discussion

Applicants assert entry of the 738-day reduction was improper.

Applicants assert the Office should have entered:

- (1) A 92-day reduction for delay in responding to the Notice to File Missing Parts,
- (2) A 74-day reduction for the filing of a reply with an omission on June 12, 2006.

A reply to the Notice to File Missing Parts was filed three months and 92 days after the Office mailed the Notice. Therefore, the Office should have entered a reduction of 92 days, not 738 days, under 37 C.F.R. § 1.704(b).

The reply to the First Notice to Comply included an omission requiring the Office to mail the Second Notice to Comply. The number of days beginning on June 13, 2006, the day after the date the reply to the First Notice to Comply was filed, and ending on August 25, 2006, the date the reply to the Second Notice to Comply was filed, is 74 days. Therefore, a 74-day reduction should have been entered under 37 C.F.R. § 1.704(c)(7).

Applicant Delay Involving Delay in Responding to the March 26, 2008 Office action

A review of the record indicates a 91-day reduction should have been entered as a result of delay in responding to the March 26, 2008 Office action.

The Office mailed an Office action on March 26, 2008. A reply was not filed until three months and 91 days later on September 25, 2008. Therefore, a 91-day reduction should have been entered under 37 C.F.R. § 1.704(b).

The Office has entered a 91-day reduction for delay in responding to the May 26, 2008 Office action.

Conclusion

As previously discussed, the Office should not have entered a 783-day reduction for delay in responding to the Notice to File Missing Parts. The Office has removed the 783-day reduction.

As previously discussed, the Office should have entered a 92-day reduction for delay in responding to the Notice to File Missing Parts. The Office has entered the 92-day reduction.

As previously discussed, the Office should have entered a 74-day reduction as a result of the filing of a reply with an omission on June 12, 2006. The Office has entered the 74-day reduction.

As previously discussed, the Office should have entered a 91-day reduction as a result of Applicants' delay in responding to the May 26, 2008 Office action. The Office has entered the 91-day reduction.

The total amount of Applicants' delay under 37 C.F.R. § 1.704, as of the date the Notice of Allowance was mailed, is 431 $(82 + 92 + 92 + 74 + 91)^2$ days.

The patent term adjustment at the time of the mailing of the Notice of Allowance is 157 days which is 588 days of Office delay under 37 C.F.R. § 1.703(a) reduced by 431 days for Applicant's delay under 37 C.F.R. § 1.704.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

² The 82-day reduction was the result of Applicants' delay in responding to the October 27, 2006 Office action and is not in dispute. The first 92-day reduction is the result of Applicants' delay in responding to the non-final Office action mailed May 29, 2006, and is not in dispute.

Day : Saturday
Date: 4/24/2010

PALM INTRANET

Time: 09:29:17

PTA Calculations for Application: 10/781059

Application Filing Date:	02/17/2004	PTO Delay (PTO):	558
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	912
Post-Issue Petitions:	0	Total PTA (days):	157
PTO Delay Adjustment:	511		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
93	04/24/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	30		
92	04/24/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	481		
83	07/10/2009	MAIL NOTICE OF ALLOWANCE			
82	07/08/2009	ISSUE REVISION COMPLETED			
81	07/08/2009	DOCUMENT VERIFICATION			
80	07/08/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
79	07/06/2009	NOTICE OF ALLOWABILITY			
72	11/06/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
71	11/05/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
69	11/03/2008	DATE FORWARDED TO EXAMINER			
68	11/03/2008	MAIL APPEALS CONF. REJ. WITHDRAWN			
67	10/31/2008	PRE-APPEALS CONFERENCE DECISION - REJECTION WITHDRAWN			
66	09/25/2008	REQUEST FOR PRE-APPEAL CONFERENCE FILED			
65	09/25/2008	NOTICE OF APPEAL FILED			
64	10/27/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
63	10/26/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
62	10/26/2008	INTERFERENCE INITIAL MEMO DISPOSAL			
61	09/25/2008	MISCELLANEOUS INCOMING LETTER			
58	09/25/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
57	03/26/2008	MAIL FINAL REJECTION (PTOL - 326)			

56	03/17/2008	FINAL REJECTION			
55	11/29/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
54	01/17/2008	DATE FORWARDED TO EXAMINER			
53	11/29/2007	RESPONSE AFTER NON-FINAL ACTION		92	49
52	11/29/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	11/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
50	11/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
49	05/29/2007	MAIL NON-FINAL REJECTION			
48	05/29/2007	NON-FINAL REJECTION			
47	11/17/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
46	05/04/2007	DATE FORWARDED TO EXAMINER			
45	04/19/2007	RESPONSE TO ELECTION / RESTRICTION FILED		82	42
44	04/19/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
43	01/04/2007	PG-PUB ISSUE NOTIFICATION			
42	10/27/2006	MAIL RESTRICTION REQUIREMENT	558		-1
41	10/26/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
39	11/17/2005	PRELIMINARY AMENDMENT			
38	02/17/2006	PRELIMINARY AMENDMENT			
37	10/17/2006	CASE DOCKETED TO EXAMINER IN GAU			
36	10/03/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
35	11/17/2004	REFERENCE CAPTURE ON IDS			
34.7	11/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
34	11/17/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
33	11/17/2004	PRELIMINARY AMENDMENT			
32	09/28/2006	APPLICATION DISPATCHED FROM OIPE			
31	09/29/2006	APPLICATION IS NOW COMPLETE			
30	08/25/2006	ADDITIONAL APPLICATION FILING FEES		738	8
29	09/28/2006	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
28	08/25/2006	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			

27	09/05/2006	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
26	06/29/2006	SEQUENCE ERRORS			
23	06/12/2006	ADDITIONAL APPLICATION FILING FEES			
22	06/12/2006	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
21	06/21/2006	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
20	04/12/2006	SEQUENCE ERRORS			
19	11/17/2004	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM			
18	02/17/2004	CLAIM PRELIMINARY AMENDMENT			
16	11/17/2004	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
15	11/17/2004	APPLICANT HAS SUBMITTED NEW DRAWINGS TO CORRECT CORRECTED PAPERS PROBLEMS			
8	05/17/2004	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
5	03/31/2004	CLEARED BY L&R (LARS)			
4	03/23/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	03/23/2004	CASE CLASSIFIED BY OIPE			
2	03/05/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	02/17/2004	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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